



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,813	10/30/2003	Donald H. Osterberg JR.	021756-067000US	2479
51206 7590 02/20/2009 TOWNSEND AND TOWNSEND AND CREW LLP TWO EMBARCADERO CENTER 8TH FLOOR SAN FRANCISCO, CA 94111-3834				
EXAMINER WHIPPLE, BRIAN P				
ART UNIT 2452		PAPER NUMBER		
MAIL DATE 02/20/2009		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/698,813

**Applicant(s)**

OSTERBERG, DONALD H.

**Examiner**

BRIAN P. WHIPPLE

**Art Unit**

2452

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1, 2, 4-9 and 11-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-9 and 11-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

#### **DETAILED ACTION**

1. Claims 1-2, 4-9, and 11-20 are pending in this application and presented for examination.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/4/09 has been entered.

#### ***Response to Arguments***

3. Applicant's arguments filed 1/5/09 have been fully considered but they are not persuasive.
4. As to claim 1, Applicant argues Kaminski may not be relied upon as prior art, because the priority date is not valid, due to the exclusion of subject matter from the provisional application, 60/497,446. The Examiner respectfully disagrees and directs the Applicant to pages 4-5 of the '446 application. In particular, page 5, substantially matches the supposedly

missing sections of the Kaminski publication relied upon (pg. 5, paragraph beginning “If Adam has not previously been authorized...”; pg. 5, paragraph beginning “If Adam is not currently authorized, Adam's mail client will send an authorization preference to the Bob's mail server...”).

5. Applicant's remaining arguments with respect to claims 1-2, 4-9, and 11-20 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-2, 4-9 and 11-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaminski et al. (Kaminski), U.S. Publication No. 2005/0044155 A1, in view of Goldman, U.S. Publication No. 2003/0233418 A1, and further in view of Quine et al. (Quine), U.S. Publication No. 2002/0023138 A1.

8. As to claim 1, Kaminski discloses an unsolicited e-mail internet protocol source address verification method (Abstract, ln. 1-3) comprising:

receiving a request for authorization to forward an electronic mail message ([0032], ln. 1-2; [0034], ln. 1-4 and 9-15);

responding to said request for authorization to forward said electronic mail message ([0035], ln. 1-3 and 8-10), wherein a response to said request for authorization includes an authorization indicator that indicates a source of said request for authorization (Kaminski: [0036], lines 10-12); and

handling receipt of said electronic mail message (Fig. 10, item 450).

Kaminski is silent on verifying the source address included in the received said electronic mail message against the address the authorization indicator is sent to.

However, Goldman discloses verifying the source address included in the received said electronic mail message against the address the authorization indicator is sent to ([0063]; the purported address is verified against itself or the manager's address through the use of an authorization request for indicating authorization).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Kaminski by verifying the source address of an electronic mail message against the given address or a manager's address as taught by Goldman in order to detect spoofed sender addresses, the occurrence of which typically

indicates junk e-mail (Goldman, [0063], lines 11-14) and/or allow a manager to control whom is classified as unauthorized in a mail system (Goldman: [0063]).

Kaminski and Goldman are silent on the authorization indicator is sent after authorization.

However, Quine discloses the authorized indicator is sent after authorization ([0101] – [0102]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Kaminski and Goldman in the aforementioned manner as taught by Quine in order to indicate a change, related to email addressing, to authorized users (Quine: [0101]).

9. As to claim 2, Kaminski, Goldman, and Quine disclose the invention substantially as in parent claim 1, including said request is initiated by a source of said electronic mail message (Kaminski: Figure 7, item 258 of SENDER'S MAIL CLIENT 14; [0034], lines 9-15) and

said request asks a simple mail transfer protocol agent for authorization to send an electronic mail message to a destination serviced by said simple mail transfer protocol agent (Kaminski: [0036], lines 1-4).

10. As to claim 4, Kaminski, Goldman, and Quine disclose the invention substantially as in parent claim 1, including said authorization indicator is send to a source address identified in said request (Kaminski: Figure 7, item 268; [0036], lines 10-12).

11. As to claim 5, Kaminski, Goldman, and Quine disclose the invention substantially as in parent claim 1, including performing an indication generator process in which an authorization indicator is generated (Kaminski: Figure 7, item 268; [0036], lines 10-12).

12. As to claim 6, Kaminski, Goldman, and Quine disclose the invention substantially as in parent claim 5, including said authorization indicator is a unique bit string (Kaminski: [0044], lines 1-3; [0045], lines 8-11).

13. As to claim 7, Kaminski, Goldman, and Quine disclose the invention substantially as in parent claim 1, including tracking said source address (Kaminski: [0036], lines 4-9).

14. As to claim 8, Kaminski, Goldman, and Quine disclose the invention substantially as in parent claim 1, including inserting an entry into said electronic mail message indicating said address said authorization indicator is sent to before forwarding said electronic mail message to an end use destination (Kaminski: [0046], lines 13-20).

15. As to claim 9, Kaminski, Goldman, and Quine disclose the invention substantially as in parent claim 1, including extracting a request source address from said request (Kaminski: [0034], lines 9-15; [0035], lines 1-3); and

utilizing said request source address as a destination address in a header file of a return package including authorization indicator information (Kaminski: [0022], lines 20-23; [0025], lines 3-4; [0035], lines 1-3; [0036], lines 10-12).

16. As to claims 11 and 17, the claims are rejected for the same reasons as claim 1 above.

17. As to claim 12, Kaminski, Goldman, and Quine disclose the invention substantially as in parent claim 11, including said instructions direct determination of electronic message authorization (Kaminski: Page 8, left column, line 47; [0032], lines 1-2; [0034], lines 1-4 and 9-15).

18. As to claim 13, Kaminski, Goldman, and Quine disclose the invention substantially as in parent claim 11, including said instructions include:

formulating a request for permission to forward an electronic message including a permission request source address (Kaminski: Figure 7, item 258; [0034], lines 9-15);



analyzing said request for permission (Kaminski: [0035], lines 1-3; [0036], lines 1-4);  
sending a permission reply to said permission request source address (Kaminski:  
[0036], lines 10-12);  
forwarding an electronic message, including said permission indicator in a header  
(Kaminski: [0044], lines 1-3; [0045], lines 8-11; [0046], lines 13-20); and  
tracking said permission request source address and a source address of said electronic  
message when received (Kaminski: [0036], lines 4-9).

19. As to claim 14, Kaminski, Goldman, and Quine disclose the invention substantially as  
in parent claim 13, including a message initiator inserts an indication in a header of a  
communication packet that said initiator is attempting to establish a communication link for  
a purpose of forwarding a message to a particular destination (Kaminski: [0038], lines 1-11),  
said header also includes an indication of an initiator or source address (Kaminski:  
[0025], lines 3-5).

20. As to claim 15, Kaminski, Goldman, and Quine disclose the invention substantially as  
in parent claim 13, including said permission reply includes a permission indicator  
(Kaminski: [0036], lines 10-12).

21. As to claim 16, Kaminski, Goldman, and Quine disclose the invention substantially as in parent claim 15, including a time stamp is maintained of when said permission indicator is generated (Kaminski: [0046], lines 5-11).

22. As to claim 18, Kaminski, Goldman, and Quine disclose the invention substantially as in parent claim 17, including transmitting a request to send said unsolicited electronic message, wherein said request includes a request sender's identification (Kaminski: [0032], lines 1-2; [0034], lines 1-4 and 9-15).

23. As to claim 19, Kaminski, Goldman, and Quine disclose the invention substantially as in parent claim 18, including said request is transmitted to a simple mail transfer protocol agent and said simple mail transfer protocol agent forwards a verification indicator to a request sender's source address (Kaminski: [0034], lines 9-15; [0035], lines 1-3).

24. As to claim 20, Kaminski, Goldman, and Quine disclose the invention substantially as in parent claim 19, including said verification indicator is a unique bit string (Kaminski: [0044], lines 1-3; [0045], lines 8-11).

***Conclusion***

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See the Notice of References Cited (PTO-892).

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRIAN P. WHIPPLE whose telephone number is (571)270-1244. The examiner can normally be reached on Mon-Fri (9:30 AM to 6:00 PM EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/698,813  
Art Unit: 2452

Page 11

Brian P. Whipple  
/B. P. W./  
Examiner, Art Unit 2452  
2/14/09

/Kenny S Lin/  
Primary Examiner, Art Unit 2452